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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,977	03/01/2002	Peter Ott	01024	2208
7590	12/01/2003		EXAMINER	
Walter Ottesen Patent Attorney P.O. Box 4026 Gaithersburg, MD 20885-4026			FINEMAN, LEE A	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/084,977	OTT, PETER
	Examiner	Art Unit
	Lee Fineman	2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 17-28 is/are pending in the application.
- 4a) Of the above claim(s) 26-28 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 17-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 17-28 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 March 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) Interview Summary (PTO-413) Paper No(s) _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

This Office Action is in response to an amendment filed 12 September 2003 in paper number 8 in which claims 1-16 were cancelled and claims 17-28 were added. Claims 17-28 are pending.

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: Figure 1 – Microscope with detection of light downstream of the objective –

Claims 17-25

Species I: Figure 4 – Microscope with detection of light upstream of the objective –

Claims 26-28

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. Newly submitted claims 26-28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: It provides detection of light upstream of the objective.

Since applicant has received an action on the merits for the originally presented invention, Species I, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

3. Claims 23-25 are objected to because of the following informalities: In claim 23, line 10 “said” objective lacks antecedent basis. The dependent claims inherit the deficiencies of the claims from which they depend. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17-19 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al., U.S. Patent No. 6,179,448 B1.

Johnson et al. disclose a system and method for adjusting a lamp unit relative to an illuminating beam path of a microscope devoid of a beam homogenizer in said illuminating beam path (column 1, lines 49-53), said microscope (fig. 1) including a microscope objective (6) defining a pupil plane; an adjustable lamp unit (12) for supplying the light transmitted along said

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illuminating beam path (fig. 1); a detector (32) for detecting the light power of the light; motor drives (30) for adjusting said light unit relative to said illuminating beam path; and an evaluation and control computer (34), that includes software, connected to said detector and functioning to sequentially drive said motor drives until a maximum of an integral light power is measured with said detector (fig. 1; column 4, lines 13-38), the method comprising the steps of measuring the integral light power downstream of said pupil plane of said objective with said detector; beginning from a start position and determining the maximum gradient of the light power in dependence upon a position change of said lamp unit relative to said illumination beam path; and displacing said lamp unit in a direction of the maximum gradient of the integral light power until the light power detected by said detector is a maximum (column 2, lines 30-57). Johnson et al. disclose the claimed invention except for the detector receiving transmitted light. Official Notice is taken of the equivalency of use of transmission and reflective systems in microscopy. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the system of Johnson et al. a transmission system to examine different characteristics of the sample.

6. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. in view of Nishi, U.S. Patent No. 5,861,944.

Johnson et al. further disclose a specimen table (2); wherein said microscope defines an optical axis along said beam path (fig. 1); and said microscope further comprises a collector optic (78, fig. 6) mounted in said illuminating beam path downstream of said lamp unit; an additional motor drive (84) for displacing said collector optic along said optical axis; and wherein the

evaluation and control computer further functions to apply the gradient method for locating said maximum of said light power by carrying out the following steps: beginning from a start position and determining the maximum gradient of the light power in dependence upon a position change of at least one of said lamp unit and said collector optic; and displacing at least one of said lamp unit and said collector optic in a direction of the maximum gradient of the integral light power (column 2, lines 30-57). Johnson et al. disclose the claimed invention as set forth above except for the detector being integrated into said specimen table. Nishi teaches a system (fig. 1) for adjusting light intensity that includes a detector (58) integrated into the specimen table (57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the detector into the specimen table in the system of Johnson et al., as suggested by Nishi, to provide a compact system that will provide accurate intensity information very near the exposure point of the specimen.

Response to Arguments

7. Applicant's arguments filed 12 September 2003 have been fully considered but they are not persuasive.

Applicant argues that Johnson et al. does not disclose or suggest a gradient method wherein measurement begins from a start position and determining the maximum gradient of the light power in dependence upon a position change of said lamp unit relative to said illumination beam path; and displacing said lamp unit in a direction of the maximum gradient of the integral light power until the light power detected by said detector is a maximum. The examiner respectfully disagrees. While the method in Johnson et al. described in column 2, lines 30-57,

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may be iterative it still is determining a maximum gradient (change of intensity of light power along a given distance/axis) and positioning the lamp to the maximum point of power.

Applicant further argues that the detector in Nishi is not appropriate for the system of Johnson et al. The examiner would like to point out that the rejection does not call for replacing the detector of Johnson et al. with the detector of Nishi, only of using the suggestion of integrating a detector into a specimen stage. Therefore, the detector used in Johnson would also be in the combination and would be appropriate to measure the light power.

8. It is noted as directed by the MPEP 2144.03 that if the applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). As such, the official notice statements of the examiner are now held to be admitted prior art.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (703) 305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9318.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



LAF

November 22, 2003



MARK A. ROBINSON
PRIMARY EXAMINER